

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

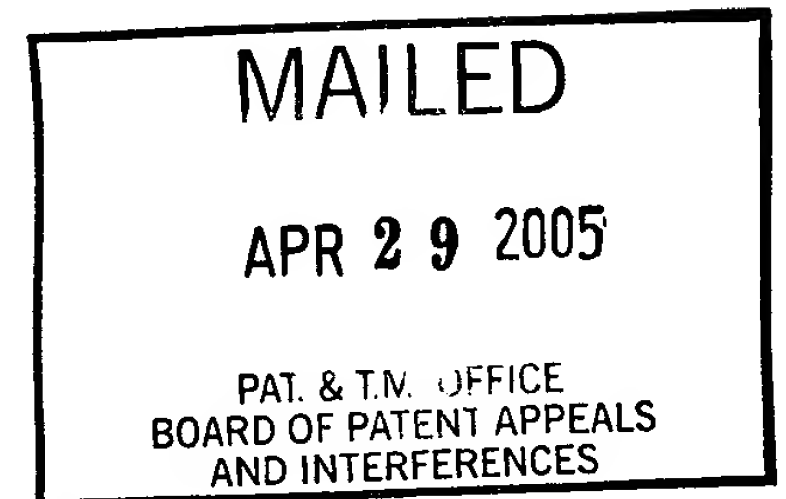
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JUNAN KAO, MICHELLE RENEE GANNON, MICHAEL GOMER
STELLJES, JR., and PAUL DENNIS TROKHAN

Appeal No. 2005-0995
Application No. 09/715,354

ON BRIEF



Before GARRIS, KRATZ, and DELMENDO, Administrative Patent Judges.
GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal which involves claims 1-20, 24 and 25.

The subject matter on appeal relates to a tissue product having various characteristics. This appealed subject matter is adequately illustrated by independent claims 1 and 17 which read as follows:

1. A generally planar substrate of tissue paper, said substrate having a length direction and a width direction defining an XY plane and a Z-direction perpendicular thereto, said substrate having a thickness taken in the Z-direction, said substrate being

extensible in at least one of said length direction and said width direction, whereby plastic extension of said substrate to a percentage in either said length direction or said width direction of said XY plane yields a percentage increase in thickness greater than said percentage elongation in said XY plane.

17. A multi-ply tissue paper comprising apertures therethrough, said multi-ply tissue paper having a coefficient of friction of at least 1.8.

No prior art has been relied upon in the sole rejection remaining on this appeal.¹

Claims 1-20, 24 and 25, which are all of the claims on appeal, are rejected under the first paragraph of 35 U.S.C. § 112 "as based on a disclosure which is not enabling" (answer, page 3). According to the examiner:

¹On page 2 of the answer, the examiner has withdrawn his Section 102 and Section 103 prior art rejections of record.

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The presence of apertures, perforations, slits or cuts are critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure [sic]. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). See page 9 of the instant disclosure. [(Id.)]^[2]

This rejection cannot be sustained at least for the reason that we find nothing and the examiner points to nothing in the subject specification which supports the examiner's contention that "[t]he presence of apertures, perforations, slits or cuts are critical or essential to the practice of the invention" (id.). Pursuant to the examiner's direction, we have studied specification page 9 but find no teaching (or even suggestion) therein which supports the examiner's aforementioned contention. To the contrary, the disclosure on lines 14-17 of this page teaches that the characteristics of the here claimed tissue product may be achieved via not only the apertures, perforations, slits or cuts referred to by the examiner but also other types of weakness lines such as "areas of significantly reduced basis weight or any other artifact" (specification page 9, lines 14-15).

²On its face, this rejection is improper with respect to the appealed claims (e.g., see independent claim 17) which recite the subject matter (e.g., apertures) said by the examiner to be "critical or essential to the practice of the invention" (id.).

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The examiner's position is also vitiated by other disclosures in the subject specification which indicate that the invention goals are achieved pursuant to lines of weakness generally (i.e., as opposed to disclosures that the specific forms of weakness lines enumerated by the examiner are critical or essential). See, for example, lines 11-14 on specification page 11 as well as lines 4-5 on specification page 19. Particularly noteworthy is the disclosure at lines 16-19 on specification page 19 which teaches obtaining the here claimed tissue product via lines of weakness in the form of low basis weight regions in combination with the disclosure at lines 11-20 on specification page 20 which teaches that multi-basis weight paper may be made according to any of 13 listed U.S. Patents.

Under these circumstances, it is apparent that the examiner has failed to carry his burden of establishing a prima facie case of nonenablement. It follows that we cannot sustain the examiner's Section 112, first paragraph, rejection of claims 1-20, 24 and 25.³

³Upon return of this application to the jurisdiction of the Examining Corps., the examiner and the appellants should consider and resolve whether appealed independent claim 17, which is directed to tissue paper "having a coefficient of friction of at least 1.8," patentably distinguishes over the prior art Pampers product which is disclosed in Table 10 on specification page 33 as having an average coefficient of friction of 1.84.

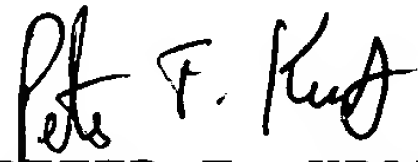
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The decision of the examiner is reversed.


REVERSED



BRADLEY R. GARRIS)
Administrative Patent Judge)



PETER F. KRATZ)
Administrative Patent Judge)



ROMULO H. DELMENDO)
Administrative Patent Judge)

BOARD OF PATENT
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